

Applicants respectfully request that the Examiner update the PTO-892 form so that the record is complete.

Claim Rejections Under 35 U.S.C. § 103(a)

a. Rejection of Claims 1-5, 8-15, 18-24 and 27-29

Claims 1-5, 8-15, 18-24 and 27-29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over “123 Free Solitaire (Golf)” in view of “Solitaire MahJongg.”

Applicants respectfully traverse the rejection of claims 1-5, 8-15, 18-24 and 27-29. Withdrawal of the rejections of claims 1-5, 8-15, 18-24 and 27-29 is respectfully requested for at least the following reasons.

i. 123 Free Solitaire (Golf)

123 Free Solitaire (Golf) discloses a reverse solitaire game wherein columns of (virtual) cards are dealt from a (virtual) deck and the remaining cards are left in a “stock” to draw from when there is no playable card in the columns of cards. See Appendix A, Fig. 1. The stock is left with the remaining cards face down prior to play. One card is dealt face up onto a “foundation.” The foundation is a pile to which cards are played in a sequence. The foundation is able to receive cards from the columns of cards that are one face value less than or one face value greater than the card showing on the foundation.

A “tableau” (playing area) includes seven (7) columns initially having five cards each. The five cards in each column are layered one above the other. Only the top card (e.g., row 1) is available for play in each column. In each column, the top card (row 1) is in overlying relationship to a card in row 2, the cards in row 2 is in overlying relationship to a card in row 3, the card in row 3 is in is in overlying relationship to a card in row 4, and the card in row 4 is in overlying relationship to a card in row 5. The card in row 1 is *partially* covering the card in row 2, but is not at least partially covering three cards in row 2.

ii Solitaire MahJongg

Solitaire MahJongg discloses a set of 144 tiles which are split into seven sets. There are three sets of numeric suits and one set of non-numeric suits. The non-numeric suits include four seasons (spring, summer, autumn and winter), four winds (east, south, west and north), four flowers (orchid, plumb blossom, bamboo and chrysanthemum) and three dragons (green, white and red). The numeric suits include “ball tiles”, “bamboo tiles” and “character tiles,” each having a number of symbols indicating the tile value, e.g., three balls is a “3” value. A first layer of tiles is arranged on a playing area with different tiles touching side to side and end to end in various patterns. A second layer may be disposed on top of the first layer in a similar fashion, disposed directly above another tile, i.e., not overlapping, or in an offset manner where a tile in the second layer overlaps two to four tiles in the first layer (e.g., the one-ball ying/yang in Fig. 3).

The rules of Solitaire MahJongg include trying to clear the playing area by removing all of the tiles from the playing area. Tiles are removed in pairs which are “free” and identical. A tile is “free” when (i) no other tile is lying above it or is partially covering it and (ii) no other tile is lying to the left of it or to the right of it. Numeric tiles of the same suit (e.g., ball tiles) and the same number (e.g., one-ball) are considered to be identical. Wind tiles, flower tiles and dragon tiles are identical if they match (e.g., two green dragons match but a green dragon and a red dragon do not). Any season tile matches any other season tile. For example, in Fig. 3, the two-bamboo in the left of the screenshot is “free” because there is no tile above or to the left and right of it, but there are no other two-bamboos “free” so it cannot be chosen for removal. The five-ball in the first layer in the lower left of the screenshot is free and the five-ball in the second layer in the upper-center of the screenshot is free because no tile is to its left, so those two tiles can be selected as a pair for removal from the screen.

iii. Claim 1

Original independent claim 1 which remains unamended recites, *inter alia*:

(a) an electronic deck of cards having a plurality of individual playing cards, each of the individual playing cards having an associated face value;

- (b) a playing area within the display;
- (c) a first layer of cards of the deck being disposed on the playing area;
- (d) a second layer of cards of the deck being disposed on the playing area in overlying relationship to the first layer of cards, at least one card of the second layer of cards partially covering at least three cards of the first layer of cards;
- (e) a shoe of cards configured to accept cards of the deck that have been selectively removed from the playing area by a player, the shoe being disposed proximate to or within the playing area; and
- (f) a set of rules dictating scoring of the electronic card game, the rules including:
 - (i) selecting cards from the playing area that are not covered by other cards and that have a face value that is one face value higher or one face value lower than the face value of the last card showing in the shoe;
 - (ii) scoring points based upon a run of play, a run of play being a duration of time when the player can selectively remove cards that are one face value higher or one face value lower than the face value of the last card in the shoe;
 - (iii) permitting a card in the first layer to become playable when all of the cards of the second layer which were partially covering the card in the first layer have been removed; and
 - (iv) allowing, in at least some instances, three or more cards in the first layer to become playable when one card of the second layer is removed.

[underline emphasis to the unamended claim added]

Applicants respectfully submit that, for the reasons that follow, there is no suggestion in either 123 Free Solitaire (Golf) or Solitaire Mahjongg to make the combination suggested by the Examiner and that making the modification cursorily suggested by the Examiner would impermissibly result in a change to the basic principle of operation of 123 Free Solitaire (Golf).

123 Free Solitaire (Golf) discloses a solitaire game having a first layer (row 2), a second layer (row 1), a third layer (row 3), a fourth layer (row 4) and a fifth layer (row 5). The card in the second layer (row 1) is *partially* covering one card in the first layer (row 2), but is not at least partially covering three cards in the first layer (row 2). The columns are separated, so each card in the second layer (row 1) is covering only one respective card in the first layer (row 2).

The Examiner acknowledges that 123 Free Solitaire (Golf) does not disclose a first layer of cards of the deck being disposed on the playing area and a second layer of cards of the deck being disposed on the playing area in overlying relationship to the first layer of cards, at least one card of the second layer of cards partially covering cards of the first layer as recited in claim 1. However the Examiner asserts that Solitaire MahJongg has layers of tiles, which the Examiner interprets to be equivalent to cards, and that by having overlapping layers of cards on a playing area one would provide game players a different look and feel to an old game.

The Applicants traverse the Examiner's argument that it would have been obvious to modify 123 Free Solitaire (Golf) by Solitaire MahJongg. While the games are each played by a single player (i.e., solitaire by definition is a card game played by one person), the rules of the two games are divergent and there would be more than a mere rearrangement of the cards in 123 Free Solitaire (Golf) into the layers suggested by the Examiner.

It is well settled that when making a rejection under 35 U.S.C. § 103, the Examiner has the burden of establishing a *prima facie* case of obviousness. MPEP § 2142. The Examiner can satisfy this burden *only* by showing an objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teaching of the references in the manner suggested by the Examiner. *In re Fine*, 5 USPQ.2d 1596, 1598 (Fed. Cir. 1988); see also MPEP § 2142.

Here, there is no clear teaching in either 123 Free Solitaire (Golf) or Solitaire MahJongg of an electronic card game having a first layer of cards and a second layer of cards of the deck being disposed on the playing area in overlying relationship to the first layer of cards where at least one card of the second layer of cards partially cover[s] at least three cards of the first layer of cards with rules allowing three or more cards in the first layer to become playable when one card of the second layer is removed wherein to be playable means that a card is one face value higher or one face value lower than the last card showing in a shoe. 123 Free Solitaire (Golf) lacks, among other things, three cards that become playable when one card of the second layer is removed. Solitaire MahJongg is played by a completely different principle of removing pairs of identical tiles that are not covered or laterally trapped.

The Examiner has failed to consider the two games as a whole, but instead has picked out features of Solitaire MahJongg to cursorily attempt to modify 123 Free Solitaire (Golf). The cursoriness of the attempted modification fails to explain how in particular to modify 123 Free Solitaire (Golf) to achieve the Applicants' invention claimed in claim 1.

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Int. 1986); MPEP § 2142. Further, the mere fact that the prior art could be modified in the manner proposed by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification. *Ex Parte Dussart*, 7 USPQ.2d 118, 1820 (PTO Bd. P. App. & Int. 1988). As the Federal Circuit has pointed out, "it is impermissible to use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 5 USPQ.2d at 1600. Moreover, something in the prior art *as a whole* must suggest the desirability, and thus the obviousness of the invention. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 5 USPQ.2d 1434, 1438 (Fed. Cir. 1988); see also MPEP § 2143.

123 Free Solitaire (Golf) includes seven columns of cards having five cards each, and the five cards in each column are layered one above the other. Only the top card (e.g., row 1) is available for play in each column. Part of the degree of difficulty is only being able to choose that top layer card on each column which is one face value higher or one face value lower than a card showing on top of a foundation pile. If the tile arrangement from any of the exemplary Solitaire MahJongg games were provided, there is no suggestion offered by the Examiner about which cards would be playable. For example, in the game labeled Fig. 3 (MahJongg Valot), any number of cards not covered in overlying relationship would possibly be playable by 123 Free Solitaire (Golf) rules.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); MPEP § 2141.02. The proposed modification or combination of the prior art invention being modified cannot change the

principle of operation of the reference. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); MPEP § 2143.01.

Even if, arguendo, there was sufficient motivation to provide seven separate piles of five cards which formed piles like, for example, the very top two layers of “Tower Bridge Solitaire MahJongg” shown in the attached Fig. 2 (“6 character” overlaying four other tiles), after removal of the top tile from each pile, four tiles in each pile would be playable in each of the seven piles - by the unmodified rules of 123 Free Solitaire (Golf) – thereby completely defeating the degree of difficulty in 123 Free Solitaire (Golf). Accordingly, the additional modification would *impermissibly* materially change the principle of operation of the 123 Free Solitaire (Golf) game, not just provide a “new look and feel.” Moreover, the suggested combination would *impermissibly* result in a substantial reconstruction and redesign of the game shown in 123 Free Solitaire (Golf) and would change the basic principle under which 123 Free Solitaire (Golf) was designed to operate.

Applicants therefore respectfully submit that claims 1-5 and 8-10 are not obvious under 35 U.S.C. § 103(a) in view of the attempted combination of 123 Free Solitaire (Golf) and Solitaire MahJongg because there is no suggestion in either reference as to the combination and because making the modification cursorily suggested by the Examiner would impermissibly result in a change to the basic principle of operation of 123 Free Solitaire (Golf). Accordingly, Applicants respectfully request that the rejection of independent claim 1 and dependent claims 2-5 and 8-10 under 35 U.S.C. § 103(a) be withdrawn.

iv. Claim 11

Original independent claim 11 which remains unamended recites, *inter alia*:

(b) placing a second layer of cards of the deck on the playing area in overlying relationship to the first layer of cards so that at least one card of the second layer of cards partially covers at least three cards of the first layer of cards;...

...

(iv) allowing, in at least some instances, three or more cards in the first layer to become playable when one card of the second layer is removed.

[underline emphasis to the unamended claim added]

For all of the reasons set forth with respect to claim 1 above, Applicants respectfully submit that there is no suggestion in either 123 Free Solitaire (Golf) or Solitaire Mahjongg to make the combination suggested by the Examiner and that making the modification cursorily suggested by the Examiner would impermissibly result in a change to the basic principle of operation of 123 Free Solitaire (Golf).

Applicants respectfully submit that claims 11-15 and 18-21 are not obvious under 35 U.S.C. § 103(a) in view of the attempted combination of 123 Free Solitaire (Golf) and Solitaire MahJongg because there is no suggestion in either reference as to the combination and because making the modification cursorily suggested by the Examiner would impermissibly result in a change to the basic principle of operation of 123 Free Solitaire (Golf). Accordingly, Applicants respectfully request that the rejection of independent claim 11 and dependent claims 12-15 and 18-21 under 35 U.S.C. § 103(a) be withdrawn.

v. Claim 22

Original independent claim 22 which remains unamended recites, *inter alia*:

(d) a second layer of gamepieces of the deck being disposed on the playing area in overlying relationship to the first layer of gamepieces, at least one gamepiece of the second layer of gamepieces partially covering at least three gamepieces of the first layer of gamepieces;...

...

(iv) allowing, in at least some instances, three or more gamepieces in the first layer to become playable when one gamepiece of the second layer is removed.

[underline emphasis to the unamended claim added]

For all of the reasons cited above with respect to claim 1 above, 123 Free Solitaire (Golf), or 123 Free Solitaire (Golf) modified by Kelly, each fails to disclose or suggest playing an electronic game having a first layer of gamepieces and a second layer of gamepieces of a deck being disposed on the playing area in overlying relationship to the first layer of gamepieces where

at least one gamepiece of the second layer of gamepieces partially cover[s] at least three gamepieces of the first layer of gamepieces with rules allowing three or more gamepieces in the first layer to become playable when one gamepiece of the second layer is removed.

Applicants therefore respectfully submit that claims 22-24 and 27-29 are not obvious under 35 U.S.C. § 103(a) in view of the attempted combination of 123 Free Solitaire (Golf) and Solitaire MahJongg because there is no suggestion in either reference as to the combination and because making the modification cursorily suggested by the Examiner would impermissibly result in a change to the basic principle of operation of 123 Free Solitaire (Golf). Accordingly, Applicants respectfully request that the rejection of independent claim 22 and dependent claims 23-24 and 27-29 under 35 U.S.C. § 103(a) be withdrawn.

b. Rejection of Claims 6-7, 16-17 and 25-26

Claims 6-7, 16-17 and 25-26 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over 123 Free Solitaire (Golf) in view of Solitaire MahJongg and U.S. Patent No. 5,882,258 (“Kelly *et al.*,” hereinafter, “Kelly”).

Applicants respectfully traverse the rejection of claims 1-5, 8-15, 18-24 and 27-29. Withdrawal of the rejections of claims 1-5, 8-15, 18-24 and 27-29 is respectfully requested for at least the following reasons.

i. Claims 6-7

Claims 6-7 depend upon independent claim 1. For all of the reasons set forth with respect to claim 1 above, Applicants respectfully submit that there is no suggestion in either 123 Free Solitaire (Golf) or Solitaire Mahjongg to make the combination suggested by the Examiner and that making the modification cursorily suggested by the Examiner would impermissibly result in a change to the basic principle of operation of 123 Free Solitaire (Golf) and/or Kelly.

Kelly fails to compensate for the deficiencies of 123 Free Solitaire (Golf) and Solitaire Mahjongg. Similar to 123 Free Solitaire (Golf), Kelly discloses a solitaire game implemented in an amusement device (game unit 10) having a display and a processor. In one

embodiment, Kelly discloses a prior art game (Super 11's in Fig. 5) where a card in a second layer (e.g., 8 Diamonds) is at least partially covering two cards in a first layer (e.g., 3 Spades and 7 Hearts). The Examiner merely relies on Kelly to demonstrate use of a wildcard in an electronic solitaire game. However, there is nothing in Kelly which would make permissible the combination of Solitaire MahJongg with either 123 Free Solitaire (Golf) or Kelly.

Further, attempting to modify Kelly by Solitaire MahJongg would yield the same impermissible result as attempting to modify 123 Free Solitaire (Golf) by Solitaire MahJongg, i.e., the attempted combination would result in a change to the basic principle of operation of Kelly.

Applicants therefore respectfully submit that claims 6-7 are not obvious under 35 U.S.C. § 103(a) in view of the attempted combination of 123 Free Solitaire (Golf) and Solitaire MahJongg and Kelly because there is no suggestion in the three reference as to the combination and because making the modification cursorily suggested by the Examiner would impermissibly result in a change to the basic principle of operation of 123 Free Solitaire (Golf) and/or Kelly. Accordingly, Applicants respectfully request that the rejection of claims 6-7 under 35 U.S.C. § 103(a) be withdrawn.

ii. Claims 16-17

Claims 16-17 depend upon independent claim 11. For all of the reasons cited above with respect to claims 6-7, Applicants respectfully submit that there is no suggestion in 123 Free Solitaire (Golf), Solitaire Mahjongg or Kelly to make the combination suggested by the Examiner and that making the modification cursorily suggested by the Examiner would impermissibly result in a change to the basic principle of operation of 123 Free Solitaire (Golf) and/or Kelly.

Applicants therefore respectfully submit that claims 16-17 are not obvious under 35 U.S.C. § 103(a) in view of the attempted combination of 123 Free Solitaire (Golf) and Solitaire MahJongg and Kelly because there is no suggestion in the three reference as to the combination and because making the modification cursorily suggested by the Examiner would

impermissibly result in a change to the basic principle of operation of 123 Free Solitaire (Golf) and/or Kelly. Accordingly, Applicants respectfully request that the rejection of claims 16-17 under 35 U.S.C. § 103(a) be withdrawn.

iii. Claims 25-26

Claims 25-26 depend upon independent claim 22. For all of the reasons cited above with respect to claim 1, Applicants respectfully submit that there is no suggestion in 123 Free Solitaire (Golf), Solitaire Mahjongg or Kelly to make the combination suggested by the Examiner and that making the modification cursorily suggested by the Examiner would impermissibly result in a change to the basic principle of operation of 123 Free Solitaire (Golf) and/or Kelly.

Applicants therefore respectfully submit that claims 25-26 are not obvious under 35 U.S.C. § 103(a) in view of the attempted combination of 123 Free Solitaire (Golf) and Solitaire MahJongg and Kelly because there is no suggestion in the three reference as to the combination, and because making the modification cursorily suggested by the Examiner would impermissibly result in a change to the basic principle of operation of 123 Free Solitaire (Golf) and/or Kelly. Accordingly, Applicants respectfully request that the rejection of claims 25-26 under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

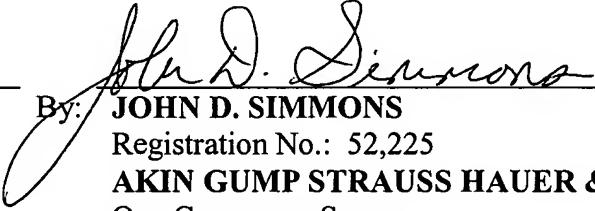
In view of the foregoing Amendments and Remarks, it is respectfully submitted that the present application, including claims 1-29, is in condition of allowance and such action is respectfully requested.

Respectfully submitted,

JEFF KARN *et al.*

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(Date)

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Enclosures: Fig. 1 is a screenshot of 123 Free Solitaire (Golf)

Fig. 2 is a screenshot of Tower Bridge Solitaire MahJongg

Fig. 3 is a screenshot of MahJongg Solitaire (by Valot)